

REMARKS

1. In response to the Office Action mailed March 12, 2008, Applicants respectfully request reconsideration. Claims 1-24 were originally presented for examination. In the outstanding Office Action, claims 1-24 were rejected. By the foregoing Amendments, claims 1-3, 5, 7-11, and 13-24 have been amended. Claims 25-29 have been added and claims 3, 4, 6 and 12 cancelled. No new matter has been added. Upon entry of this paper, claims 1-3, 5, 7-11, 13-27 will be pending in this application. Of these twenty-five (25) claims, 2 claims (claims 1 and 24) are independent.

2. Based upon the above Amendment and following Remarks, Applicants respectfully request that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

Art of Record

3. Applicants acknowledge receipt of form PTO-892 listing additional references identified by the Examiner.

4. Applicants also thank the Examiner for returning the PTO/SB/08 forms submitted by Applicants on December 22, 2004, which has been initialed by the Examiner indicating the Examiner has considered the references cited therein.

Claim Objections

5. In the outstanding Office Action, the Examiner objected to noted informalities in claims 4 and 6. These objections have been made moot by Applicant's cancelling of claims 4 and 6 above. Applicants request that these objections be reconsidered and withdrawn.

Claim Rejections under §103

6. Independent claims 1 and 24, and dependent claims 2-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,192,451 to Swerling, *et al* (hereinafter, "Swerling") in view of U.S. Patent No. 5,609,616 to Schulman, *et al* (hereinafter, "Schulman").

In light of the amendments to the claims above, Applicants note that Swerling, either alone or in combination with Schulman, fails to teach or suggest the claims invention for the following reasons.

The Combination of Swerling with Schulman is prima facie Improper

7. This rejections of claims 1 and 24 are *prima facie* improper because they provide no appropriate basis for combining Swerling with Schulman. As recently stated by the Supreme Court, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently known in the prior art.” (*See KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).) Moreover, the Supreme Court recognized in *KSR* that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some ***articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.***” (*See KSR*, 127 S.Ct. at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed. 2006).)

8. Applicants submit that the Examiner has completely failed to satisfy these legal obligations in the rejections of claims 1 and 24 under 35 U.S.C. §103. In particular, the Examiner has done what has been viewed as circumspect by the Supreme Court, and has merely provided a conclusory and unsupported statement to justify the proposed combination.

9. As noted above, the Examiner alleges that Swerling teaches all elements of claim 1, except for (1) “at least a testing station” and (2) “the testing of [a] medical device.” (*See*, Office Action, pg. 3.) To cure the first admitted deficiency of Swerling, the Examiner states without further support, “With regards to having a testing station, such would have been obvious to one of ordinary skill in the art to provide the testing system in a testing station.” (*See*, Office Action, pg. 3.) Applicants note that the Examiner likely meant to state that “such would have been obvious to one of ordinary skill in the art to provide the testing system ***with*** a testing station” and will operate under that assumption hereunder. No evidence on the record for this matter is provided to support this conclusory statement.

10. As for the second admitted deficiency of Swerling, the Examiner relies on Schulman to teach the missing element. The Examiner states, “Schulman discloses testing of cochlear

implant[s] (see title). Thus, it would have been obvious... to use the apparatus of Swerling to test medical device[s] because the device of Schulman is an electronic circuit.” (See, Office Action, pg. 3.) Not only is this justification a mere conclusory statement, but, as detailed below, this statement also lacks any “*rational underpinning*” to support the obviousness of the proposed combination as required by the Supreme Court. (See *KSR.*, 127 S.Ct. at 1741; emphasis added.)

11. Swerling is directed to a “digital diagnostic system employ[ing] signature analysis for locating faults at the system, module, or circuit component level in electronic equipment.” (See, Swerling, Abstract.) The “diagnostic system exercises the device under test to generate signatures which are... electronically compared with a stored signature.” (See, Swerling, Abstract.) Although the “unit under test” (“UUT”) in Swerling contains digital electronic circuits, *Swerling requires the UUTs to at least “provide the necessary data, start, stop and check signals to operate the signature generator 22”*, which may use a “sophisticated system including a central processing unit (CPU) 32, a RAM 34, a ROM 36, a bus 38, an input-output interface (I/O) 40, and the above mentioned digital circuits 42.” (See, Swerling, col. 3, ll. 55-66.) Using the UUT in conjunction with an in-circuit emulation module 52, “a predetermined bit pattern [is] applied to the digital circuits 42” which causes the required start, stop and check signals to be “generated and sent to the signature generator 22.” (See, Swerling, col. 5, ll. 6-10.) Signal generator is said to compress the data into a test signature. (See, Swerling, col. 5, ll. 11-13.) The microprocessing unit (MPU) 10 “compares the test signature with the correct signature stored in RAM 12... [and] if the signatures match, a message is printed... stating that the system is operating correctly and that the test is completed.” (See, Swerling, col. 5, ll. 13-14, 19-23.) FIG. 1 of Swerling reinforces the fact that data, such as the start, stop and check signals, are generated by digital circuits 56 and provided to signature generator 22 to generate a test signature for comparison against a correct signature retrieved into memory. In Swerling, the troubleshooting sequence is said to be “automatically established which leads directly to a faulty module” and that “a highly trained or skilled technician is not required to test the UUT.” (See, Swerling, Abstract, col. 6, ll. 35-36.)

12. Schulman is directed to a physician’s testing system and method for testing an implanted cochlear stimulator, using telemetry coupling. (See, Schulman, Abstract.) As described in

Schulman, and as illustrated in FIG. 7, the physician's tester is "basically a modification of the WP" (wearable processor) and is used to test a single component, namely the implanted stimulator, "to provide communication between the tester and stimulator for the monitoring, control and measurement of the stimulator parameters." (*See*, Schulman, Abstract.) In Schulman, the "physician control is embodied in a portable tester utilizing telemetry coupling to the implanted ICS, thereby providing communication between the test and ICS for the monitoring, control and measurement of the ICS parameters." (*See*, Schulman, col. 32, ll. 47-51.) Schulman further explains that "the tester monitors the performance parameters of the ICS 12 by detecting the back telemetry signal of the ICS in an interrogation protocol" and that the "physician interaction with the ICS is exercised by the use of the control panel 302 which contains electronic circuitry for conversion of the back telemetry signal into directly readable information which is read out on the LCD display 304." (*See*, Schulman, col. 33, ll. 60-68, col. 33, ll. 1-2.) It is quite clear that the physician's testing system of Schulman, unlike the device of Swerling, requires the interaction of the physician in order to operate the system.

13. In light of the teachings of Swerling and Schulman, the above conclusory statement provided by the Examiner clearly does not provide a rational underpinning to explain the proposed combination. First, the Examiner's assertion that it would have been obvious to "provide the testing system with a testing station" without any support whatsoever is totally unfounded and incorrect. No explanation or evidence is provided by the Examiner for this assertion to explain why a testing system could not operate without a "testing station" as recited by Applicants and used throughout Applicants' application. In fact, the testing systems of both Swerling and Schulman as described do not utilize a "testing station", thus seeming to directly contradict the Examiner's assertion since the fact that testing stations were not utilized in both would tend to indicate that testing stations are not generally necessary or provided in test systems. Regardless, the Examiner's unsupported conclusory statement is unfounded, therefore making the rejection based on it *prima facie* improper.

14. Second, the Examiner has attempted to justify the alleged combination by stating that using the device of Swerling to test cochlear implants would have been obvious "because the device of Schulman is an electronic circuit." (*See*, Office Action, pg. 3.) The Examiner provides no further explanation as to what this statement means or exactly why it is obvious to

conclude as the Examiner has. Regardless, Applicants note that the system of Swerling is said to be an automated system in which the user is lead automatically, without significant user interaction during the testing process, to the faulty module, such that “a highly trained or skilled technician is not required to test the UUT.” Unlike Swerling, as noted above, the Schulman system is described as involving significant physician interaction, where the physician utilizes the physician’s tester during testing to a similar degree that the recipient utilizes the wearable processor.

15. The above cited case law makes it extremely clear that without a clear, articulated reason having some rational underpinning to explain the proposed combination, an obviousness rejection under 35 U.S.C. §103 cannot be maintained. (*See KSR.*, 127 S.Ct. at 1741.) Because, as explained above, the Examiner has completely failed to provide any rational underpinning to justify the proposed combination, Applicants assert that the proposed combination of Swerling with Schulman is *prima facie* improper. As such, Applicants request that the rejection of claims 1 and 24 under 35 U.S.C. §103 be reconsidered, and that it be withdrawn.

16. Furthermore, because the Examiner has not provided any sound basis or support to justify the proposed combinations, it is clear that the Examiner is relying on information within the personal knowledge of the Examiner. Accordingly, Applicants request that the Examiner provide an Affidavit/Declaration under 37 C.F.R. § 1.104(d)(2) supporting these statements of fact that are within the personal knowledge of the Examiner and upon which the Examiner has relied on in finding motivation for combining Swerling with Schulman.

***The Proposed Combination Still Does not Contain
All Elements of Applicant’s Claim 1***

Even if the references were modified in the manner proposed by the Examiner, the resulting combination would still fail to contain all elements of the present invention as recited in claim 1. Specifically, the proposed combination of references submitted by the Examiner still fails to teach or suggest “a ***plurality of testing stations*** configured to receive and communicably couple to a ***first component being of a first type and a second component being of a second type, wherein the first component is not of the second type and the second component is not of***

the first type; and at least one testing circuit... configured to *concurrently apply a test to each of said first and second components*” as recited, in part, in Applicants’ claim 1. (See, Applicants’ independent claim 1, as amended above; emphasis added.)

17. As explained above, Swerling is directed to an automated testing system configured to test an electronic circuit, but to test such a circuit using signature analysis in an automated manner. Nowhere does Swerling teach or suggest, nor has the Examiner indicated to any portion of Swerling which is said to teach or suggest, a system which uses a plurality of testing stations to concurrently apply a test to first and second components which are of different types from one another.

18. Schulman also fails to teach or suggest the cited portions of amended claim 1. As noted above, Schulman is directed to a testing system which uses telemetry coupling to communicate test inputs and outputs to and from an implanted device. Nowhere does Schulman teach or suggest “a *plurality of testing stations* configured to receive and communicably couple to *a first component being of a first type and a second component being of a second type, wherein the first component is not of the second type and the second component is not of the first type*; and at least one testing circuit... configured to *concurrently apply a test to each of said first and second components*” as recited, in part, in Applicants’ claim 1.

19. Therefore, Applicants assert that Swerling and Schulman fail to teach or suggest that which is asserted by the Examiner and that rejection of claim 1 under 35 U.S.C. §103 is *prima facie* improper resulting from the failure of the cited combination to teach or suggest all elements of claim 1. Applicants further asserts that the other art of record, taken alone or in combination, fail to teach or suggest that which is missing from the combination of Swerling and Schulman. Therefore, for at least this reason, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. §103 be reconsidered, and that it be withdrawn.

20. Applicants assert that the rejection of independent claim 24 is also *prima facie* improper for the same or similar reasons as noted above with respect to independent claim 1. Specifically, independent claim 24 recites, in part, “a method of concurrently testing components of a medical device using a testing apparatus having *a plurality of testing stations*, comprising: receiving, by the testing apparatus, *a first component being of a first type and a*

second component being of a second type, wherein the first component is not of the second type and the second component is not of the first type... and performing a test on said first and second components concurrently.” (See, Applicants’ independent claim 24, as amended above; emphasis added.) For at least the same or similar reasons noted above with respect to claim 1, Applicants respectfully request that the rejection of claim 24 be reconsidered, and that it be withdrawn.

Dependent claims

21. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicants respectfully assert that the dependent claims are also allowable over the art of record.

New Claims

22. For the reasons discussed above with reference to claims 1 and 24, Applicants submit that new claims 25-29 are non-obvious in light of the art of record.

Conclusion

23. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

24. Applicants reserve the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application. Any cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicants reserve the right to pursue such claims in a continuation or divisional application.

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